



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,057	09/14/2005	James Hill	41577/312173	5838

23370 7590 04/09/2007
JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER

GANGLE, BRIAN J

ART UNIT	PAPER NUMBER
----------	--------------

1645

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/525,057

Applicant(s)

HILL ET AL.

Examiner

Brian J. Gangle

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) 25-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/19/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Group III in the response filed 3/9/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

The information disclosure statement filed 7/19/2005 has been considered. A initialed copy is enclosed.

Specification

The specification is objected to because the sequence of the V-antigen is deemed to be essential matter since particular amino acid positions are referenced in the description of the V-antigen.

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f). Specifically, reference to particular amino acid positions in the description of the CyaA protein are essential material which may only be incorporated by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference.

Claim Objections

Claims 17-21 and 23-24 are objected to because of the following informalities: the claims are drawn, in part, to nonelected subject matter. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejected claims are drawn to methods of treating *Yersinia pestis* infections by administering a composition comprising antibodies, or binding fragments thereof, directed to the *Yersinia pestis* F1-antigen and to the *Yersinia pestis* V-antigen. Additional limitations include the method wherein the antibodies are monoclonal antibodies and where the antibodies bind to epitopes between amino acids 135-275 or 1-275 of the V-antigen.

The specification discloses two monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, which meet the written description requirement. However, the claims encompass all antibodies which bind to the F1-antigen and to the V-antigen. These antibodies do not meet the written description requirements.

The courts have recently decided in *Randolph J. Noelle v Seth Lederman, Leonard Chess and Michael J. Yellin* (CAFC, 02-1187, 1/20/2004) that a patentee of a biotechnological invention cannot necessarily claim a genus after only describing a limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated. See *Enzo Biochem II*, 323 F.3d at 965; *Regents*, 119 F.3d at 1568. Therefore, based on our past precedent, as long as an applicant has disclosed a "fully characterized antigen," either by its structure, formula, chemical name, or physical properties, or by depositing the protein in a public depository, the applicant can then claim an antibody by its binding affinity to that described antigen. Noelle did not provide sufficient support for the claims to the human CD40CR antibody in his '480 application because Noelle failed to disclose

Art Unit: 1645

the structural elements of human CD40CR antibody or antigen in his earlier '799 application. Noelle argues that because antibodies are defined by their binding affinity to antigens, not their physical structure, he sufficiently described human CD40CR antibody by stating that it binds to human CD40CR antigen. Noelle cites Enzo Biochem II for this proposition. This argument fails, however, because Noelle did not sufficiently describe the human CD40CR antigen at the time of the filing of the '799 patent application. In fact, Noelle only described the mouse antigen when he claimed the mouse, human, and genus forms of CD40CR antibodies by citing to the ATCC number of the hybridoma secreting the mouse CD40CR antibody. If Noelle had sufficiently described the human form of CD40CR antigen, he could have claimed its antibody by simply stating its binding affinity for the "fully characterized" antigen. Noelle did not describe human CD40CR antigen. Therefore, Noelle attempted to define an unknown by its binding affinity to another unknown. As a result, Noelle's claims to human forms of CD40CR antibody found in his '480 application cannot gain the benefit of the earlier filing date of his '799 patent application.

In the instant application, applicant has failed to "fully characterize" the antigens (the F1-antigen and the V-antigen) to which the claimed antibodies bind. Consequently, since applicant has not fully characterized the antigen to which the claimed antibodies bind, the written description requirements under 35 U.S.C 112, first paragraph have not been met.

Moreover, the specification does not describe the immunoepitopes to which the members of the claimed genus of antibodies must bind in order to achieve the desired immunological response (i.e. treatment of *Yersinia pestis* infection), such that the specification might reasonably convey to the skilled artisan that applicant had possession of the claimed invention at the time the application was filed.

MPEP § 2163.02 states, "[a]n objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed' ". The courts have decided:

The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed.

Art Unit: 1645

See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Federal Circuit, 1991). Furthermore, the written description provision of 35 USC § 112 is severable from its enablement provision; and adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

The Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, paragraph 1, "Written Description" Requirement (66 FR 1099-1111, January 5, 2001) state, "[p]ossession may be shown in a variety of ways including description of an actual reduction to practice, or by showing the invention was 'ready for patenting' such as by disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention" (Id. at 1104). Moreover, because the claims encompass a genus of variant species, an adequate written description of the claimed invention must include sufficient description of at least a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics sufficient to show that applicant was in possession of the claimed genus. However, factual evidence of an actual reduction to practice has not been disclosed by applicant in the specification; nor has applicant shown the invention was "ready for patenting" by disclosure of drawings or structural chemical formulas that show that the invention was complete; nor has applicant described distinguishing identifying characteristics sufficient to show that applicant was in possession of the claimed invention at the time the application was filed.

As evidenced by Greenspan *et al.* (Nature Biotechnology 17: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan *et al.* recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an "epitope" (page 937, column 2). According to Greenspan *et al.*, an epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might

Art Unit: 1645

profoundly affect binding. Accordingly, it follows the epitope to which any given antibody binds can only be identified empirically. Even using a competition assay, the skilled artisan cannot determine whether an antibody binds the same epitope as another antibody because an antibody that competes with another does not necessarily bind the same epitope as the other; rather, one antibody may bind a spatially overlapping epitope to sterically hinder binding of the other. Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of epitopes to which the members of the claimed genus of antibodies must bind, the skilled artisan could not immediately recognize or distinguish members of the claimed genus of antibodies. Moreover, since the specification has not identified which amino acids of the genus of epitopes to which the members of the claimed genus of antibodies must bind, which are critical or essential to the binding, one skilled in the art would not recognize that applicant had possession of the claimed invention at the time the application was filed.

In conclusion, only the monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, meet the written description requirement.

Further, it should be noted that it appears applicant is attempting to incorporate the baseline sequence of the V-antigen by reference to a PCT Publication. However, according to 37 CFR 1.57, "essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference.

Claims 17-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling (after perfecting the deposit requirements for the hybridomas to produce the monoclonal antibodies, as discussed in the rejection below) for methods of treating a human or animal suffering from the effects of infection with *Yersinia pestis*, comprising administering to the human or animal, a therapeutically effective amount of a medicament comprising the monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, does not reasonably provide enablement for the methods as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Art Unit: 1645

Enablement is considered in view of the Wands factors (MPEP 2164.01(A)). These include: nature of the invention, breadth of the claims, guidance of the specification, the existence of working examples, state of the art, predictability of the art and the amount of experimentation necessary.

In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) states, "The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art." "The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling" (MPEP 2164.03). The MPEP further states that physiological activity can be considered inherently unpredictable. Thus, Applicant assumes a certain burden in establishing that inventions involving physiological activity are enabled. All of the Wands factors have been considered with regard to the instant claims, with the most relevant factors discussed below.

Nature of the invention: The instant claim is drawn to methods of treating *Yersinia pestis* infections by administering a composition comprising antibodies, or binding fragments thereof, specific for the *Yersinia pestis* F1-antigen and antibodies specific for the *Yersinia pestis* V-antigen. Additional limitations include the method wherein the antibodies are monoclonal antibodies and where the antibodies bind to epitopes between amino acids 135-275 or 1-275 of the V-antigen.

Breadth of the claims: The claims encompass all antibodies, or binding fragments thereof, that bind to the *Yersinia pestis* F1-antigen and all antibodies, or binding fragments thereof, that bind to the *Yersinia pestis* V-antigen.

Guidance of the specification/The existence of working examples: The specification provides several working examples wherein the monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, were used to treat *Yersinia pestis* infections in mice. There is no demonstration that binding fragments of these antibodies or any other antibodies are capable of providing the

Art Unit: 1645

required immune response.

State of the art: The art has shown that the monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, can be used to protect against subsequent infections, but has not shown that said antibodies, or any others are capable of treating *Yersinia pestis* infection. Although many investigators have tried to develop vaccines or treatments based on specific antigens, it is well understood that the ability of an antigen to stimulate antibody production does not necessarily correlate with the ability of the antigen to stimulate an immune response capable of protecting an animal from infection (Chandrashekar *et al.*, US Patent 6,248,329, col. 1, lines 35-41). Ellis (Chapter 29 of Vaccines, Plotkin, *et al.* (eds) WB Saunders, Philadelphia, 1988, especially p. 571, paragraph 2) exemplifies this problem in the recitation that “the key to the problem (of vaccine development) is the identification of that protein component of a virus or microbial pathogen that itself can elicit the production of protective antibodies... and thus protect the host against attack by the pathogen.” Moreover, protein chemistry is probably one of the most unpredictable areas of biotechnology. Consequently, the effects of sequence dissimilarities upon protein structure and function cannot be predicted. Bowie *et al.* (Science, 1990, 247:1306-1310) teach that an amino acid sequence encodes a message that determines the shape and function of a protein and that it is the ability of these proteins to fold into unique three-dimensional structures that allows them to function, carry out the instructions of the genome **and form immunoepitopes**. Bowie *et al.* further teach that the problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. (column 1, page 1306). Bowie *et al.* further teach that while it is known that many amino acid substitutions are possible in any given protein, the position within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of maintaining function are limited. Certain positions in the sequence are critical to the three dimensional structure/function relationship and these regions can tolerate only conservative substitutions or no substitutions (column 2, page 1306). Additionally, as evidenced by Greenspan *et al.* (Nature Biotechnology 7: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan *et al.* recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an “epitope” (page 937, column 2). According to Greenspan *et al.*, an

Art Unit: 1645

epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows that the immunoepitopes that can elicit a protective or therapeutic immune response to a given pathogen can only be identified empirically.

The specification fails to teach that any of the disclosed antibodies, other than the monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, can produce a therapeutic response in the host. In view of the lack of support in the art and specification for an effective treatment using the claimed antibodies, it would require undue experimentation on the part of the skilled artisan to make and use the vaccine as claimed; therefore the full scope of the claims is not enabled.

Claims 17-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that the monoclonal antibodies, Mab F1-04-A-G1 and Mab 7.3, are required in order to practice the invention (specifically, the hybridomas to produce these antibodies are required). The deposit of biological material is considered by the Examiner to be necessary for the enablement of the current invention (see 37 CFR 1.808(a)).

If the deposit is made under terms of the Budapest Treaty, then an affidavit or declaration by Applicants or person(s) associated with the patent owner (assignee) who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty *and* that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 CFR 1.808.

If a deposit is not made under the terms of the Budapest Treaty, then an affidavit, or declaration by Applicants or person(s) associated with the patent owner (assignee) who is in a

Art Unit: 1645

position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the following criteria have been met:

- 1) during the pendency of the application, access to the deposit will be afforded to one determined by the Commissioner to be entitled thereto;
- 2) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent; and
- 3) the deposits will be maintained for a term of at least thirty (30) years from the date of the deposit or for the enforceable life of the patent or for a period of at least five (5) years after the most recent request for the furnishing of a sample of the deposited material, whichever is longest; and
- 4) a viability statement in accordance with the provisions of 37 CFR 1.807; and
- 5) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.803 - 1.809 for additional explanation of these requirements.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim20 and 23-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is rendered vague and indefinite by the phrase "amino acids 135-275 of the sequence of the V-antigen." There is no sequence of the V-antigen provided in the specification. Therefore, with no baseline sequence to refer to, there is no way to know what amino acids the claim is referring to.

Claim 23 is rendered vague and indefinite by the phrase "amino acids 1-275 of the sequence of the V-antigen." There is no sequence of the V-antigen provided in the specification. Therefore, with no baseline sequence to refer to, there is no way to know what amino acids the claim is referring to.

Art Unit: 1645

Claim 24 is rendered vague and indefinite by the phrase "parental administration." It is not clear whether applicant intended to use the term "parenteral administration" (which refers to administration through some means other than through the gastrointestinal tract) or to "parental administration" (which would refer to administration by a parent).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Gangle whose telephone number is (571) 272-1181. The examiner can normally be reached on M-F 7-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571) 272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian Gangle
AU 1645



ROBERT A. ZEMAN
PRIMARY EXAMINER